

REMARKS

Claims 1-4, 6, 9, 12-15, 19, 20, 27, and 28 remain in the application. Claims 7 and 8 have been canceled. Only claims 1 and 21 are in independent form.

The Office Action states that the drawings are objected to because they fail to show the position retaining means in claim 9 and the resilient member in claim 5. Applicant has amended the drawings and the specification to overcome this objection. Support for the language of the position retaining means added to page 8 of the specification can be found on page 3, lines 4-6. Reconsideration of the objection is respectfully requested.

Claims 1-4, 6-9, 12-15, 19, 20, 27, and 28 stand rejected under 35 U.S.C. § 102(b), as being anticipated by Burgess (US Patent No. 476,246). Reconsideration of the rejection under 35 U.S.C. § 102(b), as anticipated by the Burgess patent, as applied to the claims, is respectfully requested. Anticipation has always been held to require absolute identity in structure between the claimed structure and a structure disclosed in a single reference.

The Office Action states that the Burgess patent discloses a golf swing indicator (10) comprising attachment means for attaching a support member (4) adjacent to a single shoulder of a golfer, the support member (4) having shoulder position indicator means projecting outwardly and forwardly from the user (11). The Office Action further states that the shoulder position indicator means (11) is adjustably secured to the support member, and includes position retaining means, because once projection (11) pivots downwardly, it will be limited to a certain position by the shoulder plate (4).

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367,

231 U.S.P.Q. 81 (Fed. Cir. 1986) it was stated: "For prior art to anticipate under §102 it has to meet every element of the claimed invention."

In Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989) it was stated: "Every element of the claimed invention must be literally present, arranged as in the claim."

Burgess discloses a breech-loading magazine gun including a projection 11 pivoted to a shoulder-plate 4 which the operator wears. The projection 11 is not fixed in any one position by the operator; it can merely pivot between two points, namely either side of the shoulder-plate 4, or the limits allowed by the butt-stock 3 and the shoulder-plate 4 when connected by the projection 11. This is also evidenced by the fact that the user still requires one hand to "hold the gun in position" (page 1, lines 70-73). The projection 11 will not remain in place on its own and requires positioning by the operator. Also, the projection 11 projects through an opening in the butt-stock 3 of the gun. Therefore, the projection 11 is not in the field of vision of the operator of the gun because the projection 11 is actually inside the butt-stock 3 when in use. Furthermore, when using a gun the operator looks down the barrel, not his shoulder, to line up a shot. The projection 11 is not used for alignment of a shot, but for the purpose of freeing up the operator's hand by keeping the butt-stock at shoulder-level. Alignment still requires the operator to adjust the gun with the operating-handle 5.

In contradistinction, the golf training aid of the present invention and as claimed in presently amended claim 1, includes shoulder position indicating means 12 that are fixedly adjustable and pivotally secured to the support member. The indicating means 12 can move in any variety of locations, but can also be affixed in that location. The indicating means 12 can pivot between positions; however, the indicating means 12 are fixed in a certain location before use. For example, a locking screw can be used to lock the

position of the indicating means 12 relative to the support member (page 8, lines 13-23). In order for the golf training aid to indicate the shoulder turn during a golf swing correctly, the indicating means 12 must stay in one position relative to the support member during the swing. Furthermore, unlike the Burgess device, the indicating means 12 of the present invention remain in the field of vision of the golfer "during substantially the full golf swing" (page 11, lines 7-10). By the indicating means 12 remaining in the field of vision of the golfer, "the golf training aid provides the golfer with feedback in relation to the position of the shoulders following impact of the ball" (page 11, lines 23-27). Such alignment of the shoulders with the help of the indicating means 12 directly allows the golfer to improve his or her golf swing. Therefore, since the Burgess patent does not disclose the fixedly adjustable shoulder indicating means or the indicating means remaining in the field of vision of the golfer of the presently pending independent claim, the claim is patentable over the Burgess patent and reconsideration of the rejection is respectfully requested.

Claims 5 and 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Burgess. According to the Office Action, Burgess discloses the invention as recited above but fails to show the indicator arm to comprise a resilient member. The Office Action holds that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a resilient member like a rubber at the tip of projection 11 for safety purposes. Reconsideration of the rejection under 35 U.S.C. § 103(a) as applied to the claims is respectfully requested.

It is Hornbook Law that before two or more references may be combined to negative patentability of a claimed invention, at least one of the references must teach or suggest the benefits to be obtained by the combination. This statement of law was first set forth in the landmark case of Ex parte McCullom, 204 O.G. 1346; 1914 C.D. 70. This decision was rendered by Assistant Commissioner Newton upon appeal from the

Examiner-in-Chief and dealt with the matter of combination of references. Since then many courts have over the years affirmed this doctrine.

The applicable law was more recently restated by the Court of Appeals for the Federal Circuit in the case of ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572,1577, 221 U.S.P.Q. 929 (Fed. Cir. 1984). In this case the Court stated, on page 933, as follows:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. Accordingly we hold that the court below erred as a matter of law in concluding that the that the claimed invention would have been obvious to one of ordinary skill in the art under section 103."

This Doctrine was even more recently reaffirmed by the CAFC in Ashland Oil, Inc. v. Delta Resins and Refractories, Inc., et al., 776 F.2d 281,297, 227 U.S.P.Q. 657,667. As stated, the District Court concluded:

"Obviousness, however, cannot be established by combining the teachings of the prior art to produce the claimed invention unless there was some teaching, suggestion, or incentive in this prior art which would have made such a combination appropriate."

The Court cited ACS Hospital Systems, Inc. in support of its ruling. This Doctrine was reaffirmed in In re Deuel, 34 USPQ2d 1210 (Fed. Cir. 1995).

As stated above, the Burgess patent does not disclose each and every element of the independent claims. The Burgess patent does not disclose the essential feature of the fixedly adjustable shoulder indicating means or the indicating means remaining in the field of vision of the golfer. Therefore, the *prima facie* case of obviousness has not been met. Reconsideration of the rejection is respectfully requested.

Claims 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Burgess in view of Coontz (US Patent No. 4,976,388). According to the Office Action, Burgess fails to teach the use of a flexible pad and the use of a shoulder pad (15), however Coontz teaches the use of a flexible shoulder pad (15). The Office Action holds that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide shoulder pads as taught by Coontz in the Burgess device in order to provide comfort for the wearer of the device. Reconsideration of the rejection under 35 U.S.C. § 103(a) as applied to the claims is respectfully requested.

In the present case, as pointed out above, Burgess does not disclose the fixedly adjustable shoulder indicating means or the indicating means remaining in the field of vision of the golfer. Coontz does in fact teach a flexible shoulder pad for use in supporting a load that the wearer is carrying. However, Burgess does not meet the *prima facie* case of obviousness as stated above. Therefore, since neither of the combined references alone or in combination suggest the currently claimed invention, it is consequently respectfully submitted that the claims are clearly patentable over the combination, even if the combination were to be applied in opposition to applicable law, and reconsideration of the rejection is respectfully requested.

The remaining dependent claims not specifically discussed herein are ultimately dependent upon the independent claims. References as applied against these dependent claims do not make up for the deficiencies of those references as discussed above, and the prior art references do not disclose the characterizing features of the independent claims discussed above. Hence, it is respectfully submitted that all of the pending claims are patentable over the prior art.

It is respectfully submitted that the present amendment places

the application in condition for allowance as it removes all remaining issues in dispute. Specifically, the amendment [does exactly what is suggested in the Office Action, that is remove all functional language in the claims]. The claims have been made no broader in scope thereby requiring no further searching and raising no new issues. In fact, all claims now include limitations of previously pending claims and were therefore previously searched. Since there is no prior art cited against any of these claims, it is respectfully submitted that all of the claims are in condition for allowance.

It is respectfully requested that the present amendment be entered in order to place the application in condition for allowance or at least in better condition for appeal. The application is placed in condition for allowance as it addresses and resolves each and every issue that remains pending. Claims have also been amended to clearly distinguish over the prior art. The application is made at least in better condition for appeal as the amendment removes many issues thereby simplifying the issues on appeal. That is, each and every rejection under 35 U.S.C. § 112 has been overcome exactly as suggested in the Office Action. Further, the claims have been amended to more specifically define the invention while raising no new issues that would require any further searching. Rather, the amendments have been made in view of comments made in the Office Action that clearly distinguish the presently pending claims over the cited prior art. Hence, it is respectfully requested that the amendment be entered.

This amendment could not have been made earlier as the amendment corrects the drawings and further defines over the prior art in accordance with the suggestion made in the Office Action, the suggestion first being made in the outstanding Office Action. Hence, since there remain no further issues to be resolved, it is respectfully requested that the present amendment be entered.

In conclusion, it is respectfully requested that the present amendment be entered in order to place the application in condition for allowance, which allowance is respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington,

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